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EXAMINER

WEEKS, GLORIA R

ART UNIT

PAPER NUMBER

3721

DATE MAILED: 05/21/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

HE

**Office Action Summary**

Application No.

09/944,009

Applicant(s)

REED, DANIEL J.

Examiner

Gloria R Weeks

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 March 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 3, 4, 7-17 and 20-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 15, 16 and 24 is/are allowed.
- 6) ☒ Claim(s) 1, 4 and 7-14 is/are rejected.
- 7) ☒ Claim(s) 3 and 25 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 04 March 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)                      4) ☒ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

***Response to Amendment***

1. This action is in response to Applicants' amendment received on March 4, 2003.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1 and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the phrase "substantially" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim 25 recites the limitation "the extender member" in line 17. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 4, 11, 14, 20-21 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Doberne (USPN 3,602,419).

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In reference to claim 1, Doberne discloses an adapter for converting a hammer tool into a multiple-impact object driving tool, the hammer tool having a housing with a barrel portion including a rear section and a nose section, the hammer having a reciprocating impact member (12), the adapter comprising: a shroud (19) for removably mounting on the hammer tool (11), having a bore (45) formed through the upper shroud between a forward and rearward end, the rearward end of the shroud removably receiving a portion of the hammer device; a drive punch (27) positioned in the bore (45) of the shroud (19) with a rear section for being impacted by the reciprocating impact member (12) and a forward end (22) for impacting an object (25) to be driven; and a guide bushing (18) extending forwardly from the shroud (19), having a forward and rearward end, a channel (20) extending through the guide bushing (18) between the forward and rearward ends for receiving a portion of the object (25) to be driven, the guide bushing (18) being slidably mounted (figures 2-3) on the front portion of the shroud (19) such that the guide bushing (18) is movable between an extended position (figure 2) and a retracted position (figure 3); wherein the channel of the guide bushing (18) has a uniform diameter along a length of the diameter.

With respect to claim 3 and its limitations as stated above, Doberne discloses an adapter for converting a hammer tool into a multiple-impact object driving tool additionally comprising an annular groove formed in an interior surface (16) of the bore (45) and a securing ring (40) removably mounted in the annular groove in the bore (45).

In reference to claim 4 and its limitations as stated above, Doberne discloses an adapter for converting a hammer tool into a multiple-impact object driving tool additionally comprising a

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biasing means (31) for biasing the guide bushing (18) into an extended position (figure 2) with respect to the shroud (19).

In reference to claim 11 and its limitations as stated above, Doberne discloses an adapter for converting a hammer tool into a multiple-impact object driving tool wherein the rear portion of the shroud (19) includes retaining means (17) for retaining the shroud (19) on the nose of the hammer tool (11).

In reference to claim 14 and its limitations as stated above, Doberne discloses an adapter for converting a hammer tool into a multiple-impact object driving tool wherein an interior surface of the bore at the rear portion has threads (17) formed thereon for threadedly engaging a helical groove on an exterior of the nose of the barrel portion of the hammer tool provided for accepting a retainer spring (31), and wherein peaks of the interior threads are semi-circular in cross-section for engaging the helical groove on the hammer tool (11).

Regarding claim 20, Doberne discloses an adapter for a hammer tool wherein the uniform diameter (forward most uniform portion containing the actual fastener 25) of the guide bushing (18) is slightly larger than the diameter of the forward end of the drive punch (27).

With respect claim 21, Doberne discloses an adapter for a hammer tool wherein the shroud (19) has an overall length, a length of the slidable guide bushing (forward most uniform portion of 18 containing the actual fastener 25) comprising approximately one-third of the overall length of the shroud and guide bushing.

Regarding claim 23, Doberne discloses an adapter for a hammer tool wherein the forward end of the drive punch (27) extends into the channel of the guide bushing (18) when the slidable guide bushing (18) is fully extended from the shroud (19; figure 2).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 7 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doberne (USPN 3,602,419) in view of York (USPN 4,030,654).

In reference to claim 7 and its limitations as stated above, Doberne discloses an adapter for converting a hammer tool into a multiple-impact object driving tool wherein the shroud (19) has an outer surface, the outer surface of the shroud having a substantially cylindrical front and rear part. Doberne does not disclose the shroud (19) including a frusta-conical intermediate part. York teaches a hammer tool having frusta-conical shroud (12) for the purpose of preventing the shroud from abutting with any adjacent walls or objects that would interfere with the positioning of the hammer tool (column 2, lines 10-14). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the shape of Doberne's shroud to the frusta-conical shape of York for the purpose of allowing the hammer tool to be better positioned while driving a fastener.

Regarding claim 12 and its limitations as stated above, Doberne discloses an adapter for converting a hammer tool into a multiple-impact object driving tool wherein the retaining means (17) for the shroud onto the hammer tool includes threads. York discloses a hammer tool with retaining means including: a longitudinal slit formed in attachment means (figure 2) and

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extending from the rearward end of the attachment toward the forward end; and a pair of retaining tabs, each of the retaining tabs being mounted on the rear portion on a side of the longitudinal slit such that the retaining tabs are located on opposite sides of the longitudinal slit; and a fastener (34) for constricting the longitudinal slit by pulling the retaining tabs toward each other (figures 2-5). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the retaining means of Doberne to that of York, since there are various known means of fastening or retaining an attachment.

8. Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doberne (USPN 3,602,419) in view of Hsu (USPN 4,830,254).

Regarding claim 8, Doberne discloses an adapter for converting a hammer tool into a multiple-impact object driving tool, the hammer tool having a housing with a barrel portion (13) including a rear section and a nose section (area of 13 with threads), a passage extending through the barrel portion (13) with an opening in the nose section extending into the passage, the hammer tool having a reciprocating impact member (12) being positioned in the passage, the adapter comprising: a shroud (19) for removably mounting on a hammer tool, the shroud (19) having a forward end and a rearward end, a bore being formed through the upper shroud between the forward and rearward ends, the shroud (16) having a rear portion located at the rearward end of the shroud for removably receiving a portion of the hammer device (27), the shroud (19) having a front portion located forward of the rear portion; a drive punch (27a) positioned in the bore of the shroud (19) with a rear section being impacted by the reciprocating impact member (12) of the hammer tool and a forward end for impacting an object (25) to be driven; a guide bushing (18) extending forwardly from the shroud (19), the guide bushing (18) having a forward

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end and a rearward end, a channel extending through the guide bushing between the forward and rearward ends for receiving a portion of the object (25) to be driven, the guide bushing (18) being slidably mounted on the front portion of the shroud (19) such that the guide bushing (18) is movable between an extended position and a retracted position. Doberne does not disclose a muffling means mounted to the shroud. Hsu teaches a hammer tool having a muffling means (76) for muffling noise and vibration (column 6, lines 18-20) mounted on the shroud (44) for mounting on the hammer tool with the shroud and removable from the hammer tool with the shroud. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the shroud of Doberne to include the muffling means of Hsu for the purpose of suppressing noise and vibrations of the hammer tool.

With respect to claim 9, the modified apparatus of Doberne in view of Hsu discloses an adapter for a hammer tool wherein the muffling means comprises a muffler member (Hsu-76) mounted on the rear portion of the shroud (Doberne-19; Hsu-76), the muffler member having a bore in communication with the bore of the shroud, an annular space being formed about the bore of the muffler member for extending about a barrel portion (Hsu-12; column 4, lines 63-65) of the hammer tool when the shroud is mounted on the hammer tool, and a muffling material for absorbing vibration being positioned in the annular space for extending about the barrel portion when the shroud is mounted on the hammer tool.

9. Claims 10 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doberne (USPN 3,602,419) as applied to claim 1 above, and further in view of Steigauf (USPN 4,519,536).



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With respect to claim 10 and its limitations as stated above, Doberne discloses an adapter for converting a hammer tool into a multiple-impact object driving tool additionally comprising a guide bushing (18), but does not disclose magnetic member mounted on the guide bushing (18). Steigauf teaches an adapter (26) for converting a hammer tool into a multiple-impact object driving tool including a magnetic member mounted on the guide bushing (26; column 1, lines 30-36 and 52-54). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the guide bushing of Doberne to include the magnetic member of Steigauf for the purpose of holding an object (25) to be driven in the guide bushing.

With respect to claim 22, Doberne discloses an adapter for converting a hammer tool wherein the drive punch (27) terminates at the forward most end of the guide bushing (18), but not the shroud (19). Steigauf teaches an adapter for a hammer tool having a shroud (40), guide bushing (32) and drive punch (22) wherein the drive punch terminates at a forward most end of the front portion of the shroud (figures 6-7). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the shroud and guide bushing of Doberne to that of Steigauf for the purpose of protecting the user while the hammer tool is in use (Steigauf- abstract, lines 1-4; column 2, lines 63-68; column 3, lines 1-12).

10. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Doberne (USPN 3,602,419) as applied to claim 1 above, and further in view of Dudek (USPN 3,734,515).

Regarding claim 13 and its limitations as stated above, Doberne discloses an adapter for converting a hammer tool into a multiple-impact object driving tool wherein the retaining means (17) for the shroud (19) onto the hammer tool (11) includes threads. Dudek discloses tool with retaining means including: a recess (64) formed in a portion of the shroud (48), the recess (64)

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extending between a bore in the shroud and an exterior of the shroud; a locking ball (62) positioned in the recess (64) and being movable in the recess (64) between a locked position in which the locking ball (62) extends into the bore (64) for engaging an exterior of a nose section (60) of the tool, and an unlocked position in which the locking ball (62) is substantially completely retracted into the recess (64); a lever (70) movably positioned in the recess (64), the lever (70) having a locked position in which the lever (70) presses the locking ball (62) into the locked position and an unlocked position in which the lever permits the locking ball to retract into the recess (column 3, lines 7-27) It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the retaining means of Doberne to include the retaining means of Dudek since there are various known means of fastening or retaining an attachment.

11. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Doberne (USPN 3,602,419) in view of Gupta (USPN 4,139,137) and Steigauf (USPN 4,519,536).

In reference to claim 17, Doberne in view of Gupta and Steigauf discloses an adapter for converting a hammer tool into a multiple-impact object driving tool as disclosed in the combination of the rejections made above.

***Allowable Subject Matter***

12. Claim 3 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

13. Claims 15-16 and 24 are allowed.

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14. Claim 25 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

### ***Response to Arguments***

15. Applicant's arguments filed March 4, 2003 have been fully considered but they are not persuasive. In reference to Applicant's argument that the adapter of Doberne lacks a guide bushing with a uniform diameter, Examiner disagrees due to Doberne's illustration of a guide bushing having a uniform diameter at the upper portion of the guide bushing, as well as the lower portion of the guide bushing.

16. Applicant's arguments with respect to claims 8-9 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gloria R Weeks whose telephone number is (703) 605-4211. The examiner can normally be reached on 7:30 am - 6:00 pm Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I Rada can be reached on (703) 305-2187. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-1789.

Gloria R Weeks  
Examiner  
Art Unit 3721



grw  
May 19, 2003



**EUGENE KIM  
PRIMARY EXAMINER**